

REMARKS

Claims 1-14 are all the claims pending in the application. Claims 1-3 and 9-14 are allowed.

Claims 4-8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Goodall in view of Allen and Aoi. In particular, the Examiner states that “[the Declaration] is not commensurate in scope with the claims,” and that “claim 4 reads on any surfactant having F and/or Si.”

In addition to the remarks previously submitted and the evidence already of record, Applicants submit herewith an executed Declaration Under 37 C.F.R. § 1.132 by Mr. Kenichiro Sato supplemental to the Declaration Under 37 C.F.R. § 1.132 filed July 18, 2003. Applicants respectfully request the Examiner to enter and consider the supplemental Declaration at this stage of prosecution as placing the case in condition for allowance.

In the present Declaration, the resins used were those set forth in Examples 56 and 58 in Goodall et al (within the scope of the present invention) and the resin set forth in Example 60 in Goodall et al (a comparative resin, outside the scope of the present invention). Examples b and g and Comparative Examples 1 and 2 shown in Table 1 of the present Declaration are the same as Examples b and g and Comparative Examples 1 and 2, included in the Declaration filed July 18, 2003.

Examples C and D were prepared in the same manner as Example b, except that the surfactants used were a fluorine-containing surfactant (W-1) and a silicon-containing surfactant (W-3), respectively. Examples E and F were prepared in the same manner as Example g except

that the surfactants used were a fluorine-containing surfactant (W-1) and a silicon-containing surfactant (W-3), respectively. Comparative Examples E' and F' were prepared in the same manner as Comparative Example 1 or 2 except that the surfactants used were a fluorine-containing surfactant (W-1) and a silicon-containing surfactant (W-3), respectively.

As is apparent from the comparison of Examples C and E with Comparative Example E' and the comparison of Examples D and F with Comparative Example F', the Comparative Examples failed to form satisfactory images, and could not achieve an unexpected and excellent effect similar to that of the present invention, in terms of the number of development defects as well as the DOF pitch dependency.

See also Comparative Examples b' and g', including the resin of the present invention but no surfactant, in the data of the Declaration Under 37 C.F.R. §1.132 filed November 22, 2002.

Therefore, the present invention achieves particularly preferable and unexpected effects on the number of development defects and DOF pitch dependency by the combination of a specified resin with a specified surfactant.

Another unexpected advantage is seen in the order of the particle (initial value), where the compositions of the present application unexpectedly show small particle numbers immediately after preparation.

In view of the above, it is respectfully submitted that the subject matter of claims 4-8 is patentable over the disclosures of Goodall in view of Allen and Aoai, and it is requested that the rejections under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Response Under 37 C.F.R. § 1.116
U.S. Appln. No. 09/541,597

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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